

Appl. No. 09/703,542  
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Reply to Office Action of 01/29/2004

### REMARKS/ARGUMENTS

The specification is amended hereinabove to correct minor typographical errors and language informalities. Applicant respectfully requests that the Examiner enter the indicated amendments to the specification. No new matter is added.

There are no amendments to the drawings or claims herein.

The Examiner contended that the title of the invention is not descriptive and required Applicant to provide a new title that is "clearly indicative of the invention to which the claims are directed". In particular, the Examiner suggested that the new title include "configuration determination" and "passive" to "depict the gist of the invention".

Applicant respectfully submits that the title is both descriptive and fully compliant with the rules and guidelines for a patent application title as set forth in 37 CFR §1.72 and as suggested by MPEP §606 *Title of Invention*. In particular, the title as originally filed is both technically accurate and descriptive of the invention in as much as at least both base Claims 1 and 11 both recite, in part, "... monitoring a communications network ... data stream characterization". Therefore, the Applicant respectfully declines to amend the title. Reconsideration is respectfully requested.

In the Claims, Claims 1-20 are pending and remain in the application. Claims 1-3, 5-7, 9-14, 16-18 and 20 are rejected. Claims 4, 8, 15, and 19 are objected to. Reconsideration is respectfully requested.

The Examiner rejected Claim 1 under 35 U.S.C. 102(b) as being anticipated by Hershey et al. (US Pat. No. 5,793,753). The Examiner contended, in part, that "Hershey et al. disclose '[a] system for monitoring and managing the operations of a multi-technology telecommunications network' (Fig. 2)(monitoring, data packets, plurality of nodes)" that "physically connects to the network (physical connection)(See Fig. 2, 22a and 22b)" using probes that are preferably "nonintrusive or passive (Col. 1, line 52) (plurality of measurement probes ... passively)" for collecting "data transfer activity (collecting the data)". The Examiner further contended Hershey et al. disclose the monitoring system comprises "interpreter workstations (computational units)" which "communicate with one or more probes

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(receiving ... from a respective one of the plurality of probes) ... configuration parameter" and which process the configuration parameter "(producing) ... in an easily viewable format (characterization)(Col. 3, lines 43-53), to monitor several network functions including network configurations (Col. 6, lines 36-37)(generating a system configuration ... from the data stream characterization)".

Applicant traverses the rejection on the grounds that the Examiner had failed to establish a case for *prima facie* anticipation with respect to Hershey et al. In particular, Applicant submits that Hershey et al. do not disclose, explicitly or implicitly, each and every element recited in Claim 1 as required to establish a case for *prima facie* anticipation under 35 USC 102.

Applicant respectfully reminds the Examiner that to maintain an anticipation rejection, "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripts Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

As noted by the Examiner, Hershey et al. do disclose a telecommunications network management observation and response system, as well as passive probes for monitoring data transfer activities on the network. However, contrary to that contended by the Examiner, Hershey et al. neither disclose each and every element recited in Claim 1 nor disclose each element arranged as in the claim. The Federal Circuit has stated that "anticipation requires the disclosure in a single prior art reference each element of the claim under consideration". *W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In addition, the Federal Circuit has stated that each element disclosed by the reference must be "arranged as in the claim". *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984). As such, Applicant respectfully submits that it is incorrect to infer that there is "no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention" as required for a finding of *prima facie* anticipation with respect to Hershey et al. *Scripts Clinic & Research Found. V. Genentech Inc.*, cited *supra*.

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For example, Hershey et al. neither disclose data streams nor disclose data packets carried by the data streams. Furthermore, Hershey et al. fail to disclose or suggest a data stream characterization produced from data packets collected by probes on or in the network. Furthermore, Hershey et al. do not disclose generating a system configuration or generating the system configuration from the data stream characterizations.

In particular and contrary to that contended by the Examiner, "providing the data to the system manager in an easily viewable format", as disclosed by Hershey et al., is neither a "data stream characterization" nor a disclosure of producing the same. On the contrary, Applicant, acting as his/her own lexicographer, has clearly defined a "data stream characterization" in the specification of the instant application to be "a set of data stream parameters derived from measurements" on a set of collected data packets, the data stream characterization representing "the network traffic at a specific point in the network" (Page 9, lines 17-22). As such, a "viewable format" has no relationship to the data stream characterization of the instant application.

Moreover, Applicant discloses that "data stream characterizations act as unique markers or fingerprints for tracking the flow of data through the network" (Page 10, lines 2-3 of Applicant's specification). In addition, Applicant stipulates that "a data stream characterization comprises a sequence or string of values" and that the characterization produced by a characterization computational unit (CCU) "utilize an invariant portion" of the collected data packets. Applicant provides at least four different embodiments of data stream characterizations including a hash characterization, a count characterization, an interval characterization, and a multi-packet characterization (see Page 14, starting on line 27 of Applicant's specification).

These specific references, as well as the balance of Applicant's specification, should be adequate to distinguish Applicant's use of the term 'data stream characterization' and to distinguish Applicant's disclosure regarding producing the data stream characterization from anything disclosed or suggested by Hershey et al. In particular, it should be clear that the "viewable format" disclosed by Hershey et al. and cited by the Examiner is not a data stream characterization according to the instant invention.

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Moreover, failing to disclose data stream characterizations or the production of the same, Hershey et al. further do not (and cannot) disclose using such characterizations for generating a system configuration. As such and without more, Hershey et al. fail to disclose each element of the claimed invention "arranged as in the claim". *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., supra*.

As noted hereinabove, the Examiner cited Hershey et al., at Col. 6, lines 36-37, "to monitor several network functions including network configurations" in support of a contention that Hershey et al. disclosed "generating a system configuration ... from the data stream characterization". In fact, at Col. 6, lines 36-38, Hershey et al. disclose that the monitoring system "provides the capability to monitor several network functions including network configurations, faults, performance, customer accounting and security". Monitoring "network functions", as disclosed by Hershey et al., are not the same thing as "generating a system configuration", as recited in Claim 1 of the instant application.

Notwithstanding the lack of a disclosure of data stream characterizations, Hershey et al. do not otherwise disclose generating a system configuration. In particular, Applicant respectfully submits that the Examiner is mistaken in contending that "monitor several network functions including network configurations" corresponds to generating a system configuration, as recited in Applicant's Claim 1. While it is possible that the Examiner may have confused the term "network configuration", as employed by Hershey et al., with the term "system configuration" used by Applicant, the fact is that the two terms are entirely unrelated.

Specifically, Hershey et al. employ the term "network configuration" to refer to data structures or parameters thereof within the monitored network. For example, Hershey et al. disclose that "[n]etwork configuration includes such parameters as network signaling and VT1.5 mapping for SONET" (Col. 4, lines 46-48). SONET is a high-speed optical network standard. "Network signaling" and "VT1.5 mapping" refer to features in the SONET standard that allow for multiplexing or packaging relatively lower speed data from multiple communication sources into a SONET data payload. For example, 'VT1.5 mapping' refers to a virtual tributary (VT) structure

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within the SONET data payload. The VT1.5 mapping essentially defines a data substructure within a SONET data frame that can receive and hold data from a 1.5 Mb/s signal. The VT1.5 mapping is unrelated to a physical structure of the network as well as to a connection topology or virtual connection configuration of the network.

In contrast, "system configuration" as defined in the instant specification refers to a "configuration of the virtual circuits in the network" (Page 9, lines 23-24 of Applicant's specification). In other words as defined in the instant application, the system configuration is concerned with how data actually flows from source to sink within the network. As such, "network configuration", as used by Hershey et al., is distinctly different from "system configuration", as employed in the instant application.

Thus for at least the reasons cited hereinabove, the Examiner has not established a case for *prima facie* anticipation of Claim 1 with respect to Hershey et al. In particular, the Examiner has failed to show that there is no difference between the claimed invention and the reference disclosure, that the reference teaches each and every element of Applicant's claimed invention, and that each element is arranged as in the claim. Therefore, the rejection of Claim 1 under 35 U.S.C. 102 is unsupported and should be withdrawn for at least the reasons set forth hereinabove.

The Examiner rejected Claims 2 and 5 under 35 U.S.C. 103(a) as being unpatentable over Hershey et al. in view of Galloway (US Pat. No. 5,430,709). In particular, the Examiner admitted that Hershey et al. fail to disclose hash values and contended that Galloway discloses that lacking in Hershey et al. with respect to hash values. The Examiner further contended that it would have been obvious "to include the hash tables constructed based on invariant portion(s) of received data packets", according to the teachings of Galloway, "in order to develop data stream characterization" in the monitoring system of Hershey et al.

Applicant traverses the rejection on the grounds that the Examiner has failed to establish a case for *prima facie* obviousness over Hershey et al. in view of Galloway. Applicant respectfully submits that the Examiner has not provided a suggestion or motivation to modify or combine the teachings of Hershey et al. and Galloway that is found either in the references themselves or in the knowledge generally available to

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one of ordinary skill in the art. The Federal Circuit has held that in order to establish *prima facie* obviousness (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success in the proposed modification/combination that is found in the references themselves, and that (3) the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Instead, the Examiner simply provided a broad conclusory statement about a particular, proposed modification or combination of the teachings of the references. The Federal Circuit has held, "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Specifically, the Examiner contended that one skilled in the art would have been 'motivated' to modify Hershey et al. to include the teachings of Galloway with respect to Claims 2 and 5 "to include the hash tables constructed based on invariant portion(s) of received data packets in order to develop data stream characterization". While arguably expressing possible or desirable outcomes of the proposed modifications, the Examiner's contended motivation does not meet the standards for such a motivation or suggestion as set forth by the courts and, instead is merely a broad conclusory statement.

The Examiner has provided no evidence to support that the alleged "motivation" is "found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (*In re Vaeck*, cited *supra*, and see MPEP 2143.01 *Suggestion or Motivation to Modify the References*). The Federal Circuit was clear stating, "[i]n rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Applicant submits that the Examiner has not and respectfully cannot point to any specific evidence in the teachings of Hershey et al.

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and Galloway, whether taken separately or together, that would support, either implicitly or explicitly, the contended combination/modification for the motivation given by the Examiner.

In short, a showing by the Examiner of a motivation to combine requires "evidence that 'a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.'" *Ecolchem, Inc. v. Southern Calif. Edison Co.*, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Applicant reminds the Examiner that "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In fact, absent the teachings of Applicant's disclosure, there is simply no motivation for the specific modification suggested by the Examiner. To contend otherwise is an inappropriate use of hindsight. The court has held that "[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." *In re Fritch*, 972 F. 2d. 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) quoting *In re Fine*, 837 F. 2d. 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)".

In addition, Claims 2 and 5 ultimately depend from and includes all of the limitations of base Claim 1. As discussed hereinabove, Hershey et al. fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claim 1. Furthermore, the teachings of Galloway fail to add that which is lacking in the teachings of Hershey et al., such that Hershey et al. in view of Galloway fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claims 1 (*In re Vaeck*, cited *supra*). Therefore, Hershey et al. in

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combination with Galloway further fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's Claims 2 and 5, as required for establishing a case of *prima facie* obviousness.

Finally, Applicant respectfully reminds the Examiner that in addition to a motivation to combine and a showing that the references teach or suggest all of the claim limitations, a case for *prima facie* obviousness also requires a finding in the references themselves of an expectation for success in the suggested combination. *In re Vaeck*, cited *supra*. The Examiner has not pointed out any evidence of an expectation of success found in either cited reference for the modification or combination proposed by the Examiner.

Thus, Applicant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of Applicant's Claims 2 and 5 with respect to Hershey et al. in view of Galloway. Reconsideration and withdrawal of the unsupported rejection of Claims 2 and 5 are respectfully requested.

The Examiner rejected Claims 3, 6, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable over Hershey et al. in view of Galloway and further in view of Egbert (US Pat. No. 6,356,551). The Examiner admitted that Hershey and Galloway do not disclose "a number of times each possible hash value occurs", as recited in part in Claim 3. However, the Examiner contended that Egbert discloses "monitoring of the number of table entries for a given bin" at Col. 12, lines 29-30 of USPN 6,356,551. The Examiner concluded that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to include "a number of times each possible hash value occurs" as a criterion for data stream characterization. With respect to Claims 6, 7 and 9, the Examiner admitted that Hershey and Galloway do not disclose "an XOR hash algorithm", as recited in part in Applicant's Claims 6, 7 and 9. However, the Examiner contended, "Egbert discloses 'The hash polynomial generator 100 includes ... a series of exclusive OR gates (XOR) 204, and a shift register 206' at Col. 13, lines 3-5 (XOR hash algorithm)." The Examiner concluded that it would have been obvious to choose an XOR hash algorithm for characterization.



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Applicant traverses the rejection on the grounds that the Examiner has failed to establish a case for *prima facie* obviousness over Hershey et al. in view of Galloway further in view of Egbert, for at least the same reasons as Applicant set forth above for the rejection of Claim 1 over Hershey et al. and the rejection of Claims 2 and 5 over Hershey et al. in view of Galloway. In particular, the Examiner has not established the existence of a suggestion or motivation to modify or combine the reference teachings of Hershey et al., Galloway and Egbert that is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (*In re Vaeck*, cited *supra*).

That notwithstanding, the Examiner's contended motivation for combining Egbert with the teachings of Hershey et al. and Galloway is also nothing more than a broad conclusory statement expressly devoid of evidentiary support in either the references themselves or in the knowledge generally available to one of ordinary skill in the art (*McElmurry v. Arkansas Power & Light Co.*, cited *supra*). Applicant reminds the Examiner that "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *In re Dembiczak*, cited *supra*. Applicant submits that without the teaching of the instant invention, there is no suggestion or motivation for one skilled in the art to make the modification/combination suggested by the Examiner.

Moreover, Claims 3, 6, 7, and 9 ultimately depend from and include all of the limitations of base Claim 1. As discussed hereinabove, Hershey et al. in combination with Galloway fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claim 1. Furthermore, the teachings of Egbert fail to add that which is lacking in combined the teachings of Hershey et al. and Galloway, such that Hershey et al. and Galloway in view of Egbert fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claim 1. Therefore, Hershey et al. in view of Galloway further in view of Egbert also fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's Claims 3, 6, 7, and 9, as required for establishing a case of *prima facie* obviousness (*In re Vaeck*, cited *supra*).

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Finally, the Examiner has not pointed to any evidence of an expectation of success found in any of cited references for the modification/combination proposed by the Examiner, as is also required for establishing a case of *prima facie* obviousness (*In re Vaeck*, cited *supra*).

Thus, Applicant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of Applicant's Claims 3, 6, 7, and 9 with respect to Hershey et al. in view of Galloway further in view of Egbert. Reconsideration and withdrawal of the unsupported rejection of Claims 3, 6, 7, and 9 are respectfully requested.

The Examiner rejected Claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Hershey et al. in view of Ahearn et al. (US Pat. No. 5,926,463). The Examiner admitted that Hershey et al. do not disclose configuration generation via "successively comparing data stream characterizations", as recited in part in Applicant's Claim 10. In particular, the Examiner cited in Ahearn et al. at Col. 8, lines 25-28, a disclosure that "[a]fter a configuration poll is completed, the Router Watch means will compare the received data to the previous data (current baseline plus deltas from all configuration polls since the baseline) and detect any differences". The Examiner emphasized such terms as 'configuration' and 'compare' from the citation and appeared to implicitly contended some correlation "(successively comparing), (find matching – claim 10, identify matching – claim 11)", which confused Applicant. The Examiner further contended that it would have been obvious "to use a comparison technique to find configuration differences and in the case of no change, take the matching pairs, to characterize the system".

Applicant traverses the rejection on the grounds that the Examiner has failed to establish a case for *prima facie* obviousness over Hershey et al. in view of Ahearn et al. In particular, the Examiner fails to provide a suggestion or motivation to modify or combine the reference teachings of Hershey et al. and Ahearn et al. that is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art as required by the courts. *In re Vaeck*, cited *supra*. The Examiner's contended motivation is simply a broad conclusory statement without any required evidentiary support (*McElmurry v. Arkansas Power & Light Co.*, cited *supra*).

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Moreover, Applicant respectfully submits that the combination of the teachings of Hershey et al. with the teachings of Ahearn et al. as proposed by the Examiner does not disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's Claims 10 and 11, as required to establish *prima facie* obviousness (*In re Vaeck*, cited *supra*).

In particular with respect to Claim 10, Claim 10 depends from and includes all of the limitations of base Claim 1. As discussed hereinabove, Hershey et al. fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claims 1. As such, Hershey et al. similarly fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's Claims 10. Furthermore, the teachings of Ahearn et al. fail to add that which is lacking in the teachings of Hershey et al., such that Hershey et al. in view of Ahearn et al. fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claim 1 and, by extension, *all* of the elements and/or limitations recited in Applicant's Claim 10.

For example, Ahearn et al. disclose at Col. 8, lines 25-28, comparing received data to previous data to "detect any differences" produced by a configuration poll. The data collected during the configuration poll is "key configuration data" obtained from routers (Col. 8, lines 17-19 of Ahearn et al.). As such, the data collected is not related to the data stream itself and therefore cannot be a data stream characterization, as defined in the instant application.

Similarly, Hershey et al. in combination with Ahearn et al. fail to disclose or even to suggest *all* of the elements and/or limitations recited in Applicant's base Claim 11. For example, neither Hershey et al. nor Ahearn et al. disclose or suggest a "data stream characterization" or "determining a data stream characterization", as recited in Applicant's base Claim 11. Furthermore, having failed to disclose a data stream characterization, one or both of Hershey et al. and Ahearn et al. do not and cannot disclose "comparing the data stream characterizations to one another to identify matching characterizations", as recited in Claim 11 of the instant application.

Moreover and contrary to that suggested by the Examiner, the comparison disclosed by Ahearn et al. is used to "detect any differences" (Ahearn et al., Col. 8,

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lines 25-28). Detecting differences, regardless of the nature of the differences or the data employed is in direct opposition to "identifying **matching** characterizations" (**emphasis added**), as recited in Applicant's Claim 11. (Likewise detecting differences is opposite to finding "matching pairs", as recited in Applicant's Claim 10). Thus, not only do Hershey et al. in view of Ahearn et al. not disclose each element/limitation of Applicant's base Claim 11, Ahearn et al. essentially teaches away from "identifying matching characterizations", as recited in Claim 11 and finding "matching pairs", as recited in Claim 10. The 'teaching away' by Ahearn et al. merely serves to further support Applicant's submission that Ahearn et al. fails to add to that lacking in Hershey et al.

Moreover, the Examiner has not pointed to any evidence of an expectation of success found in either Hershey et al. or Ahearn et al. to support the modification/combination proposed by the Examiner, as is further required to establish a case for *prima facie* obviousness (*In re Vaeck*, cited *supra*).

Thus, Applicant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of Applicant's Claims 10 and 11 with respect to Hershey et al. in view of Ahearn et al. Reconsideration and withdrawal of the unsupported rejection of Claims 10 and 11 are respectfully requested.

The Examiner rejected Claims 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Hershey et al. in view of Galloway and further in view of Ahearn et al. The Examiner admitted that Hershey et al. and Galloway do not disclose how to determine a data stream characterization. However, the Examiner contended that Ahearn et al. disclose "information about the interfaces is stored in the status watch database" at Col. 16, lines 40-41. It appears that the Examiner has implicitly correlated this disclosure by Ahearn et al. to "recording peripheral information", as recited in part in Applicant's Claim 12. The Examiner concluded that it would have been obvious "to record peripheral information presented in data streams to characterize the system configuration".

Applicant traverses the rejection on the grounds that the Examiner has failed to establish a case for *prima facie* obviousness over Hershey et al. in view of Galloway further in view of Ahearn et al. The Examiner has failed to provide any evidence

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supporting the existence of a suggestion or motivation to modify or combine the reference teachings that is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, as required by the courts. *In re Vaeck*, cited *supra*. A broad conclusory statement regarding the teachings of the cited references is not evidence (*McElmurry v. Arkansas Power & Light Co.*, cited *supra*). Likewise, the Examiner has not pointed out any expectation of success found in the cited references, as further required for establishing *prima facie* obviousness (*In re Vaeck*, cited *supra*).

Moreover, Claims 12 and 13 ultimately depend from and include all of the limitations of base Claim 11. It has been set forth above that the Examiner had failed to show that Hershey et al. in view of Ahearn et al. disclose all of the elements of Applicant's Claim 11 (which is also further required to establish a case for *prima facie* obviousness. *In re Vaeck*, cited *supra*). It is respectfully submitted that Galloway fails to add to that lacking in the teachings of Hershey et al. and Ahearn et al. to render Applicant's base Claim 11 obvious. Therefore, Hershey et al. in view of Galloway and further in view of Ahearn et al. do not disclose all elements of Applicant's base Claim 11.

Additionally, Applicant respectfully reminds the Examiner that if an independent base claim is non-obvious under 35 U.S.C. 103, any claim depending therefrom is likewise non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). As such, having failed to establish *prima facie* obviousness with respect to base Claim 11 as detailed hereinabove, the Examiner has similarly failed to establish *prima facie* obviousness with respect to dependent Claims 12 and 13. Thus, the rejection under 35 U.S.C. 103(a) of Claims 12 and 13 is improper and must be withdrawn.

The Examiner rejected Claims 14, 16, 17, 18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Hershey et al. in view of Galloway, Ahearn et al., and further in view of Egbert. The Examiner contended that the teachings of Egbert add to that lacking in the teachings of Hershey et al., Galloway and Ahearn et al. to make Claims 14, 16, 17, 18, and 20 obvious.

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Applicant traverses the rejection on the grounds that the Examiner has failed to establish a case for *prima facie* obviousness over Hershey et al. in view of Galloway, Ahearn et al., and further in view of Egbert. In particular as discussed hereinabove in the previous rejections, the Examiner has failed to provide any evidence supporting the existence of a suggestion or motivation to modify or combine the reference teachings that is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Moreover, the Examiner has failed to show that any of these cited references disclose a reasonable expectation of success in the proposed modification/combination. In addition, the Examiner has not and cannot show that the prior art references teach or suggest *all* the claim limitations. *In re Vaeck*, cited *supra*. The Examiner has merely made a broad conclusory statement, which is not evidence. *McElmurry v. Arkansas Power & Light Co.*, cited *supra*. Unless the Examiner meets the initial burden of providing sufficient, court recognized evidence for a case of *prima facie* obviousness (*Ecolochem, Inc. v. Southern Calif. Edison Co.* and *In re Rouffet*, both cited *supra*), the burden does not shift to Applicant. *In re Rijckaert*, cited *supra*. Applicant respectfully submits that the Examiner has merely combined the cited references using Applicant's disclosure as a blueprint for piecing together the cited references to defeat patentability. *In re Dembiczak*, cited *supra*. Such action by the Examiner is impermissible. *In re Fritch* and *In re Fine*, both cited *supra*.

That notwithstanding, Claims 14, 16, 17, 18, and 20 ultimately depend from and include all of the limitations of base Claim 11. As such, having failed to establish *prima facie* obviousness with respect to base Claim 11 as detailed hereinabove, the Examiner has similarly failed to establish *prima facie* obviousness with respect to dependent Claims 14, 16, 17, 18, and 20. Thus for the reasons set forth above, the rejection under 35 U.S.C. 103(a) of Claims 14, 16, 17, 18, and 20 is improper and must be withdrawn.


Applicant appreciates the Examiner's recognition of the allowability of Claims 4, 8, 15, and 19 if rewritten in independent form. However, given Applicant's arguments hereinabove with respect to the rejections of base Claim 1 under 35 U.S.C. 102 and base Claims 1 and 11 under 35 U.S.C. 103, Applicant respectfully declines to amend Claims 4, 8, 15, and 19 at this time. Reconsideration is respectfully requested.

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In summary, Claims 1-20 are pending. Claims 1-3, 5-7, 9-14, 16-18 and 20 were rejected and Claims 4, 8, 15, and 19 were objected to. Applicant submits that Claims 1-20 are in condition for allowance. It is respectfully requested that Claims 1-20 be allowed, and that the application be passed to issue at an early date.

Should the Examiner's action be other than allowance of Claims 1-20, the undersigned respectfully requests a telephone call from the Examiner to discuss further consideration that would expedite the prosecution of the application. Moreover, should the Examiner have any questions regarding the above, please contact the undersigned, J. Michael Johnson, telephone number (775) 849-3085, or Robert T. Martin, Attorney for Applicant, Registration No. 32,426 at Agilent Technologies, Inc., telephone number (650) 485-7533.

Respectfully submitted,  
SIMON LOVE ET AL.

By:   
J. Michael Johnson  
Attorney/Agent for Applicant(s)  
Registration No. 37,856  
(775) 849-3085

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office to the Central Facsimile Number on the date shown below.

  
J. Michael Johnson

4/12/04  
Date

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